Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

Claims 85-107, 116-119 and 121-124 stand rejected under 35 U.S.C. 103 as allegedly being unpatentable over Daneels in view of Robertson. This contention is respectfully traversed, and it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a prima facie showing of unpatentability.

The rejection cites Robertson as showing an electronic book formed of a plurality of images forming a Web book. Column 4 of Robertson describes this as a "metaphor", a system returning Web pages that look like book pages. For example, this is shown in Figure 3. The rejection admits, however, that Robertson does not teach determining the request for pages exceeding a certain threshold and sending the information only if the threshold is not exceeded. The rejection cites Danneels for this purpose.

However, as a threshold matter, it would not be proper to combine Robertson with Danneels, since there is no incentive in either Robertson or Danneels to, as the Examiner calls it, enable "users to download a limited book over the network". Rather, everything in Robertson teaches unlimited access to the e-book. Each time a user wants to obtain more parts of the book, the user requests another part of the book. There is absolutely no teaching or suggestion in Robertson of anything that would suggest limiting access to the book. Therefore, it would not be obvious to combine Robertson with something that limits access to the book of Robertson. For example, column 3 lines 30 of Robertson describes "providing access to documents...", not limiting access to documents. Nowhere is there any teaching or suggestion of limiting

2

the access. Rather, everything within Robertson is directed to providing, not limiting, the access. Therefore, this is an improper combination.

Even assuming arguendo that the system of Robertson were somehow combined with Danneels, it would obtain an Robertson type system along with Danneels' teaching that conditions for the web page may be dependent on certain status conditions of the system or related to the system. See for example Danneels' column 3 beginning line 20. The kinds of status which could be used to limit the web page sets are the status of the video camera, the status of the motion detecting sensor, or the processing load of the server. See generally column 3 lines 25-29. Note that certain files can be retained and other files are only retrieved based on the state of the "current state variable" column 4 line 11. However, the current state variable is based on the conditions 34. Again, however, those conditions are based on status of the camera, load on the server, column 3 lines 32, current time of day, column 3 line 36, or other SYSTEM parameters. Nowhere is there any teaching or suggestion of the claimed subject matter where the condition is "if the request for pages exceeds a certain threshold". Danneels teaches only conditions that are related to time of day, load on the server, or presence of hardware. There is no teaching or suggestion that the condition could be a threshold of the number of pages. It is quite simply hindsight to attempt to interpret the readings of Danneels in this way. Moreover, it is wholly unreasonable to attempt to interpret Danneels as though it covers conditions which are totally different than the specific kinds of "conditions" mentioned therein.

Therefore, if Robertson and Danneels were combined, assuming this would be possible, one would obtain an Robertson type web book, which limited the pages

3

depending on SYSTEM status, e.g., status of the content, status of the hardware, load on the server, or time of day. Nowhere is there any teaching or suggestion of limiting the pages based on the number of pages which have been requested. Moreover, nothing in the hypothetical combination suggests this, or anything like this. System status as suggested by Danneels teaches nothing that would suggest number of page limit.

The claimed system enables previewing book pages without giving all the possible book pages. It prevents a user from reading the entire book over the Internet, such as would be desirable in a bookstore type environment. This is not taught or suggested by the cited prior art, and hence should be allowable thereover.

The dependent claims should be similarly allowable. Claim 86 defines that images are classified about whether they count towards the threshold or not. This is not taught or suggested by Robertson in view of Danneels. The rejection refers to column 2 lines 23-67 of Robertson. This cited section simply refers to the turning of pages of a book, and rotating of the book. This teaches nothing about incrementing a counter only when the image counts towards the threshold. Claim 9 specifies that the computer file expires after a certain amount of time. Again this is not taught or suggested by any of the cited prior art.

Claim 96 defines displaying a screen tip indicating what the reaction will be to a specified operation. The rejection alleges that Robertson's column 7 lines 41-60 teaches this. However, the cited section simply states that the data structure is dynamic and changes as the book is changed, includes a graphical control portion, page objects and status information, as well as various information for interactive graphical objects.

4

Nowhere is there any teaching or suggestion of "displaying a screen tip indicating what the reaction will be to a specified operation" in the context of images with textual information and non-textual information as claimed. Therefore, claim 96 should be additionally allowable along with the claims that depend therefrom.

Claim 98 defines that the images use graded resolution which provides readable resolution for the readable parts and a different resolution for non-readable parts. The rejection alleges that this is shown in Robertson's column 8 lines 3-59. The cited section does show rendering the content of a book, but teaches nothing about resolution, much less the specific resolution which is defined by claim 98.

Claim 100 defines displaying keys which enable moving the position of viewing of the information. The rejection states that these claims "are analyzed as previously discussed with the respected (sic) to claims 96-98". Nowhere does the teaching above teach anything about keys which enable moving the position of viewing. The undersigned has reviewed Robertson and finds no teaching or suggestion of such keys that enable changing the position of viewing.

Claim 101 defines that these keys change meaning based on their position, and again this is not taught or suggested by the cited prior art.

Claim 102 defines a system which receives information, displays images and detects a number of pages and limits use of the number of pages. As discussed above, this is not taught or suggested by the hypothetical combination cited by the rejection, and therefore should be allowable thereover. Claim 103 specifies limiting use of only a specified page type, again not taught or suggested by the cited prior art.

Claim 105 defines determining if more than a specified number of pages have been requested and sending the pages only if the specified number of pages does not exceed a threshold. Again this is not taught or suggested by the hypothetical combination of prior art. The rejection states that the threshold reads on Danneels' column 5 lines 1-22. Again, however, this describes the "conditions", where the conditions were previously described as being states of sensors ,states of variables, load on the server, or time of day. Nowhere is there any teaching or suggestion that the condition is the number of pages of the book which have been sent. Therefore, claim 105 should be allowable.

Claim 106 should be additionally allowable for reasons discussed above with respect to claim 103. Claim 107 specifies that the user can read beyond the specified number of pages after paying a fee. Nowhere is there any teaching or suggestion of this in the prior art.

Claim 116 specifies limiting pages of books that can be viewed and returning images of pages of the books based on limiting and requesting. Again nothing in the hypothetical combination of Robertson in view of Danneels teaches or suggests limiting number of pages, requesting pages and returning images only if the limit is not exceeded.

Claim 117 specifies increasing the quality of the image, which is not taught or suggested by any of the cited prior art.

Claim 121 specifies that limited pages of books can be retrieved over the network, and that the computer limits the number of pages that can be displayed. Nowhere is there any teaching or suggestion of this in the cited prior art, as described

6

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

above. The dependent claims should also be allowable for reasons discussed above with respect to the respective independent claims.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.
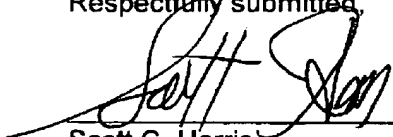
Therefore, all of the claims should be allowable for these reasons.

Should the Examiner have any issues remaining after considering this amendment, the Examiner is respectfully encouraged to call the undersigned at the below telephone number, in an attempt to most expeditiously resolve these issues.

If there are any other charges, or any credits, please apply them to Deposit Account No. 50-1387.

Respectfully submitted,

Date: 1-31-05

Scott C. Harris
Reg. No. 32,030

7

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

Customer No. 23844
Scott C. Harris, Esq.
P.O. Box 927649
San Diego, CA 92192
Telephone: (619) 823-7778
Facsimile: (858) 678-5082

8